

REMARKS

This Application has been carefully reviewed in light of the Final Office Action mailed December 28, 2004 (the "Office Action"). In the Office Action, Claims 1, 4-7, 9, 11, 14, 16-19, 21-22, 26-29, 31, 34-38, 40, 42-43, and 46-54 are pending. The Examiner rejects Claims 1, 4-7, 9, 11, 14, 16-19, 21-22, 26-29, 31, 34-38, 40, 42-43, and 46-54. Applicants amend Claims 1, 11, 21, 31, 40, and 43. Applicants submit that the claim amendments do not add new matter. Applicants respectfully requests reconsideration and favorable action in this case.

Rejections Under §103

The Examiner rejects Claims 1, 4-7, 9, 11, 14, 16-19, 21-22, 26-29, 31, 34-38, 40, 42-43, and 46-54 under 35 U.S.C. §103(a) as being obvious over U.S. Patent 6,259,701 issued to Shur et al. ("*Shur*") in view of U.S. Patent 6,138,144 issued to DeSimone et al ("*DeSimone*") and U.S. Patent No. 6,020,916 issued to Gerszberg et al. ("*Gerszberg*"). The Examiner rejects Claim 41 under 35 U.S.C. §103(a) as being obvious over *Shur* in view of *DeSimone* and *Gerszberg* as applied above, and further in view of U.S. Patent No. 5,963,547 issued to O'Neil et al. ("*O'Neil*"). Applicants respectfully traverse these rejections for the reasons stated below.

The Claims are Allowable over the Cited References

To defeat a patent under 35 U.S.C. § 103, "the prior art references must teach or suggest all the claim limitations." *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991); M.P.E.P. § 706.02(j). Applicants respectfully submit that the proposed combinations of references do not disclose, teach, or suggest each and every element recited in Applicants' claims.

For example, Claim 1 of the present application recites the following:

A method for enabling a multicast telecommunication session, comprising:

- receiving a call initiation request indicating a desire to create a communication link between a multicast telephony device and a unicast telephony device;

- determining that the unicast telephony device is incapable of receiving multicast media streaming;

- generating a virtual multicast intermediary in response to determining that the unicast telephony device is incapable of receiving multicast media streaming;

- receiving multicast media streaming sent to a multicast group address from a plurality of multicast telephony devices at the virtual multicast intermediary;

- sorting, at the virtual multicast intermediary, the multicast media streaming sent to the multicast group address from the plurality of multicast telephony devices into individual streams based on the telephony devices that originated each stream;

- communicating, from the virtual multicast intermediary, the sorted media streaming to a unicast telephony device to enable the unicast telephony device to participate in a multicast telecommunication session;
- and

- indicating to the unicast telephony device that the individual media streams of the sorted media streaming originated from different multicast telephony devices.

Thus, Claim 1 recites: 1) sorting, at the virtual multicast intermediary, the multicast media streaming sent to the multicast group address from the plurality of multicast telephony devices into individual streams based on the telephony devices that originated each stream and 2) communicating, from the virtual multicast intermediary, the sorted media streaming to a unicast telephony device to enable the unicast telephony device to participate in a multicast telecommunication session. Claims 11, 21, 31, and 40 recite similar, although not identical, limitations.

In the Office Action, the Examiner relies on *DeSimone* for disclosure of the first enumerated limitation. (Office Action, pages 3-4). Applicants respectfully submit, however, that *DeSimone* does not disclose, teach, or suggest this limitation. Rather, *DeSimone* discloses “a multicast capable IP network implemented over an ATM network.” (Abstract). “Each of the client terminals is connected to the IP network 102 over ATM. Each client terminal 101-1 - 101-5 has a unique ATM unicast endpoint address.” (*DeSimone*, Col. 4, lines 50-54). Accordingly, *DeSimone* merely discloses a system that allows *unicast* client terminals existing

on different IP sub-networks to conference with one another. To enable such a conference, *DeSimone* discloses that a Directory Server 106 maintains “a list of multicast IP addresses and ports available for use for a plurality of different and possibly concurrent conferences, to assign a subset of those addresses and ports to a particular conference when a conference is initiated, and to assign from that subset a unique multicast IP address and port number to each media type of each client as that client makes a request to become a member of that conference.” (Column 5, lines 5-12). “Once each socket (multicast IP address and port number) is assigned to a particular client . . . , the assigned multicast IP addresses are marked as being unavailable and cannot be assigned to any other client attempting to join that same conference.” (Column 5, lines 13-17). Thus, in addition to each client having an assigned unicast address, each client is also assigned a unique multicast address.

When a client joins an established conference, “it receives a list of sockets used for transmitting by the other clients associated with the conference.” (Column 5, lines 30-33). The client participating in the conference, then “sets its local interface to receive only those packets whose multicast IP addresses/port numbers match the ones in its [Multicast Receive Address List (MRAL)].” (Column 5, lines 41-43). *DeSimone* illustrates use of the system through an example:

For example, if client terminals 101-4 and 101-5 each wants to receive the video transmitted by client terminal 101-1, client terminals 101-4 and 101-5 register their ATM unicast addresses with MARS server 126, which then associates those ATM unicast addresses with the multicast IP address that client terminal 101-1 uses for video transmission. When client terminal 101-1 transmits, therefore, it sends the multicast IP address on which it transmits its video to MARS server 126 and receives therefrom a list of ATM unicast addresses to which ATM connections should be established. Client terminal 101-1 then sets up a point-to-multipoint virtual circuit to the ATM [unicast] addresses of client terminals 101-4 and 101-5.

(Column 5, line 57 through Column 6, line 2). Thus, *DeSimone* specifically discloses that a separate point-to-point session is established between each transmitting terminal and each receiving terminal. Additionally, when transmitting, a client transmits video on its own unique multicast IP address. Since the video is transmitted over different point-to-point virtual circuits and is addressed based on the transmitting client, *DeSimone* cannot be said to disclose, teach, or

suggest “sorting, at the virtual multicast intermediary, the multicast media streaming sent to the multicast group address from the plurality of multicast telephony devices into individual streams based on the telephony devices that originated each stream,” as recited in Claim 1, and similarly, though not identically, recited in Claims 11, 21, 31, and 40. Such sorting would be completely unnecessary using the system of *DeSimone*.

Even where an ATM Multicast Server (MCS) is used “in order to share point-to-multipoint connections,” when client terminal 101-1 transmits video, “it sends the multicast IP address on which it transmits its video to MARS server 126” (Column 6, lines 31-34; Column 7, lines 2-4). “MARS server 126 then sends the list of ATM unicast addresses to which ATM connections need to be established to MCS 130.” (Column 7, lines 4-6). “MCS 130 then sets up a point-to-multipoint virtual circuit to the ATM addresses of clients 101-4 and 101-5.” (Column 7, lines 6-8). *DeSimone* doesn’t disclose that transmission is any different from that described above. Thus, even using a MCS, it appears that Client 101-1 still transmits video using the multicast address and port specifically assigned to client 101-1. Thus, sorting as recited in Applicants’ claims is not disclosed in *DeSimone* and remains unnecessary to the *DeSimone* system.

For at least these reasons, Applicants respectfully submit that *DeSimone* does not disclose, teach, or suggest “sorting, at the virtual multicast intermediary, the multicast media streaming sent to the multicast group address from the plurality of multicast telephony devices into individual streams based on the telephony devices that originated each stream,” as recited in Claim 1, and similarly, though not identically, recited in Claims 11, 21, 31, and 40.

As another example, Applicants respectfully submit that the proposed *Shur-DeSimone-Gerszberg* does not disclose, teach, or suggest “communicating, from the virtual multicast intermediary, the sorted media streaming to a unicast telephony device to enable the unicast telephony device to participate in a multicast telecommunication session,” as recited in Claim 1, and similarly, though not identically, recited in Claims 11, 21, 31, and 40. In the Office Action, the Examiner again acknowledges, and Applicants agree, that *Shur* does not disclose, teach, or suggest the “sorting” step discussed above. (Office Action, page 3). Nevertheless, the Examiner relies on *Shur* for disclosure of “communicating . . . the sorted media streaming.”

(Office Action, pages 3-4). Applicants pose the question: How could *Shur* possibly disclose a "communicating, from the virtual multicast intermediary, the sorted media streaming" since *Shur* fails to even disclose "sorting, at the virtual multicast intermediary, the multicast media streaming," as recited in Claim 1? This inconsistency seems to illustrate that the Examiner has merely pieced together disjointed portions of unrelated references to reconstruct Applicants' claims.

For at least these reasons, Applicants believe that Claims 1, 11, 21, 31, 40, and 43 are allowable over the cited references. Therefore, Applicants respectfully request reconsideration and allowance of Claims 1, 11, 21, 31, 40, and 43, and all claims that depend from those claims.

One of Ordinary Skill in the Art Would not have been Motivated to Make the Proposed *Shur-DeSimone-Gerszberg* Combination

Moreover, assuming for purposes or argument that the proposed combination discloses the limitations of Applicants' claims, which Applicants dispute, it would not have been obvious to one skilled in the art to make the combination. The mere fact that references can be combined does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680 (Fed. Cir. 1990). The showing must be clear and particular. *See, e.g., C.R. Bard v. M3 Sys., Inc.*, 48 USPQ.2d 1225, 1232 (Fed. Cir. 1998). The Examiner speculates that "it would have been obvious . . . to have provided the multicast media streaming from the plurality of telephony devices of *Shur* with their own special IP addresses, in light of the teachings of *DeSimone et al*, so that the media would indicate to the unicast device 111 that it is from different sources (and where it is from), so that it could be filtered by the unicast (as in *DeSimone et al*), and so that it could use this information to properly route it via member 113 to the proper unicast client terminals." (Office Action, page 4). Applicants respectfully submit, however, that the provided motivations do not provide a suggestion to combine these two references.

It is essential to view the invention as a whole, taking each element into account as well as the advantages, properties, utilities, and results of the invention. *In re Chupp*, 816 F.2d 643, 2 U.S.P.Q.2d 1437 (Fed. Cir. 1987). As discussed above, the very principle and purpose of the system disclosed in *Shur* is the conversion of a group multicast IP address to a unicast IP

endpoint address, and vice versa. *Shur* discloses that the group address allows "all senders [to] address their transmitted information to this group and all receivers are "tuned" to "listen" to that address to receive the information transmitted to that group by the senders. (Column 1, lines 19-22). Accordingly, "[t]he senders of information are thus effectively de-coupled from the set of receivers. Senders do not need to know who the receivers are – they simply transmit packets to information transmitted to that group by the senders." (Column 1, lines 22-25). Conversely, Applicants have shown above that the system disclosed in *DeSimone* assigns each client a unique multicast IP address to which data is transmitted by the respective clients. Even if the unique IP addresses disclosed in *DeSimone* identify the sources of the media, as the Examiner suggests, this disclosure is contrary to the teachings of *Shur* and to the very core principles of multicast transmissions. Accordingly, Applicants respectfully submit that one of ordinary skill in the art at the time of invention would not have been motivated to combine the disclosure of *Shur* with the disclosure of *DeSimone*.

Furthermore, it is improper for an Examiner to use hindsight having read the Applicant's disclosure to arrive at an obviousness rejection. *In re Fine*, 837 F.2d 1071, 1075, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988). It is improper to use the claimed invention as an instruction manual or template to piece together the teachings of the prior art so that the claimed invention is rendered obvious. *In re Fritch*, 972 F.2d 1260, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992). The inconsistencies in *Shur* and *DeSimone*, as identified by Applicants above, evidences the Examiners reconstruction of Applicants' claims by using hindsight to piece together disjointed portions of analogous, but inconsistent references.

For at least these reasons, Applicant respectfully submits that the proposed *Shur-DeSimone-Gerszberg* combination is improper. Accordingly, the rejection of Applicant's claims over the proposed *Shur-DeSimone-Gerszberg* combination should be withdrawn.

CONCLUSION

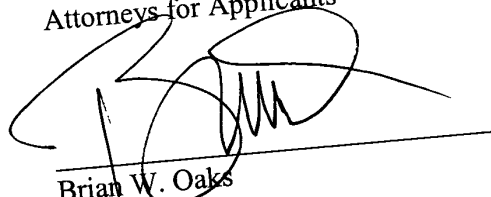
Applicants have made an earnest attempt to place this application in condition for allowance. For the foregoing reasons, and for other reasons clearly apparent, Applicants respectfully request reconsideration and full allowance of all pending claims.

If the Examiner feels that a telephone conference would advance prosecution of this application in any manner, the Examiner is invited to contact Brian W. Oaks, Attorney for Applicants, at the Examiner's convenience at (214) 953-6986.

Although Applicants believe that no fees are due, the Commissioner is hereby authorized to charge any fees or credit any overpayment to Deposit Account No. 02-0384 of Baker Botts, L.L.P.

Respectfully submitted,

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